



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,396	09/24/2001	Stephen McCann	3036/50289	5628

7590 05/02/2006

Crowell & Moring L.L.P.
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300

EXAMINER

WILLIAMS, JEFFERY L

ART UNIT	PAPER NUMBER
----------	--------------

2137

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/960,396

Applicant(s)

MCCANN ET AL.

Examiner

Jeffery Williams

Art Unit

2137

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 April 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER

Applicant argues primarily that:

(i) The Office Action states that the foreign agent FA of Turunen corresponds to the visitor authentication, authorization and accounting (VAAA) server of Applicants' claim 1, and that the home agent HA of Turunen corresponds to the home authentication, authorization and accounting (HAAA) server of Applicants' claim 1. However, Turunen is completely silent on either the home agent HA or foreign agent FA having any type of accounting function. ("Remarks", 4/5/06, page 6).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a type of accounting function) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

(ii) Regarding conveying to the VAAA server by user intervention identity information, the Office Action states that a user moving the mobile host to a foreign network corresponds to the user intervention. However, Applicants' claim 1 recites that the identity information is conveyed "by user intervention" and not merely that after a user moves a mobile host that the host automatically sends information to its home agent HA as disclosed by Turunen ("Remarks", 4/5/06, page 7).

In response, the examiner respectfully directs the applicant's attention to the prior Office Actions, as this argument has been addressed before and was found to be unpersuasive. Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., identity information is conveyed "by user intervention" and not merely that after a user moves a mobile host that the host automatically sends information to its home agent HA as disclosed by Turunen) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

(iii) There is no disclosure or suggestion in Turunen of the foreign agent FA being enabled by the received identity information to communicate with the home agent HA as would be required to reject Applicants' claim 1 under the reasoning provided by the Office Action. ("Remarks", 4/5/06, page 7).

In response, the examiner respectfully directs the applicant's attention to the prior Office Actions, as this argument has been addressed before and was found to be unpersuasive (see Final Rejection, 11/7/05, pg. 4, lines 8-23; pg. 9, lines 1-11). Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

(iv) Turunen does not disclose or suggest that the internet security key, or the authentication data derived from the key, is used by a browser to "authenticate the requested visiting access to the W-LAN." In other words, Turunen does not disclose or suggest that the internet security key or anything derived from the key is used for authenticating access to the first W-LAN ("Remarks", 4/5/06, page 8).

In response, the examiner respectfully directs the applicant's attention to the prior Office Actions, as this argument has been addressed before and was found to be unpersuasive (see Final Rejection, 11/7/05, pg. 4, lines 8-23; pg. 9, lines 13-18). As previously stated in prior Actions of the Office, Turunen discloses accessing a foreign network in order to use the internet. This proposed connection to the internet using the foreign network is authenticated with a PIN (Turunen, par. 1). Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the key is used for authenticating access to the first W-LAN) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(v) Refer to applicant's arguments ("Remarks", 4/5/06, pages 8 – 10) regarding the references of Turunen, Salo, and Mouly.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(vi) Salo, like Turunen, is completely silent on accounting functions. Accordingly, Salo cannot disclose or suggest a visitor authentication, authorization and accounting (VAAA) server or home authentication, authorization and accounting (HAAA) server as recited in Applicants' claim 1 ("Remarks", 4/5/06, pg. 8).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., accounting functions) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

(vii) Because *In re Venner* is directed to a permanent mold casting apparatus and not an access authentication system as recited in Applicants' claim 3, the facts of *In re Venner* are not sufficiently similar to those of the claims currently being examined. Additionally, unlike the claims in *In re Venner* that "broadly" provided an automatic means to replace a manual activity, Applicants' claim 3 recites particular structure, such as including software supported by the portable computing device, that transfers the PIN, thereby further highlighting the inapplicability of *In re Venner* to the claims currently under examination.

Because the case law relied upon by the Office Action is not applicable to the facts claim 3, and because the Office Action has not provided a prior art reference that discloses or suggests all of the elements of this claim, the Office Action has not provided enough information to establish a *prima facie* case of obviousness with respect to claim 3 ("Remarks", 4/5/06, pg. 11).

In response the examiner maintains that the recitation "automatically" of claim 3 is obvious in view of the prior art. As was previously stated in prior actions of the Office, the examiner asserts that it was well known to those of ordinary skill in the art to accomplish a result by replacing non-automatic means with automatic means (Evidenced by Parasuraman et al., "A Model for Typed and Levels of Human Interaction with Automation", Abstract, pgs. 1-9). The applicants' assertion that the facts of *In re Venner* are not sufficiently similar to those of the claims currently being examined is unpersuasive. Regarding *In re Venner*, the facts pertain to a result that is accomplished by automatic means, as opposed to the same result being accomplished by non-automatic means. In this instance, the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. Similarly, claim 3 of the instant application simply recites the accomplishment of a result "automatically" by some means - as opposed to claiming the accomplishment of the same result non-automatically by some means. Thus, contrary to the applicants' assertion, the replacement of a non-automatic means with an automatic means is obvious.

Furthermore, Applicants assert Applicants' claim 3 recites particular structure, such as including software supported by the portable computing device, that transfers the PIN, thereby further highlighting the inapplicability of *In re Venner* to the claims currently under examination. However, Applicants are mistaken. Applicants have not shown any particular structure, namely software that transfers the PIN, other than the structure that already exists in the prior art. The browser (software) that receives the pin is inseparably included in the means for transferring the PIN to the browser. If such means, the software (the browser itself) did not exist, then transfer of a PIN to the browser could not happen. Thus, while proceeding to claim what is inherent by virtue of the existing browser (software), Applicant's fail to recite any additional particular structure ... thereby further highlighting the inapplicability of *In re Venner* to the claims currently under examination.

(viii) While the care-of-address of Turunen is sent to the home network in order to enable the home network to redirect datagrams to that new care-of-address, the PIN of Salo is used to authenticate the access to the remote access device. Accordingly, it appears that the rejection of claim 5 is based upon improper hindsight reconstruction in which various elements of Turunen and Salo are selected for the sole purpose of rejecting Applicants' claim 5, and not because one skilled in the art would have considered the combination of such elements obvious. ("Remarks", 4/5/06, pg. 12).

Regarding the above argument the examiner respectfully directs the attention of applicant's representative to the rejection of claim 5. Particularly, the applicant's representative is invited to examine the complete cited portions of the references of Turunen and Salo as cited in the prior actions of the Office. The applicant's representative is further invited to understand the rejection of claim 5 in its proper context as was presented by the examiner in the prior actions of the Office (please consider the rejection of claim 1, Final Rejection, 11/7/05). Herein, the examiner shows that the authentication data of Turunen, is used to authenticate, and that a browser, as disclosed by Salo, may be employed.

Furthermore, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(ix) The combination of Turunen, Salo and Mouly does not render Applicants' claims 6 and 7 obvious because the combination does not disclose or suggest that "the PIN is combined with masking information" as recited in claim 6 or that said masking information is randomly derived" as recited in claim 7 ... However, a mere encoding of an authentication key cannot be regarded as a combination with masking information, but instead, the authentication key of Turunen is transmitted as such ("Remarks", 4/5/06, pg. 13).

In response, the examiner respectfully directs the applicant's attention to the rejection of claims 6 and 7 as found in the prior Office Actions. Furthermore, Applicants are directed to consider the Applicant's own disclosure (i.e. Instant Application, pars. 17,19) wherein the Applicants admit that the combination with masking information is the encoding of the PIN.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Continuation of 11. does NOT place the application in condition for allowance because: The Applicants' amendments change the scope of claims 1 - 9, and further search and consideration is required. As previously presented, the claims recited a mobile telephone that possessed a valid cellular mobile account. As presently amended, the claims recite a user that possesses a valid cellular mobile account..

